

**REMARKS**

Claims 1-15 are pending in the application.

Claims 1-15 have been rejected.

Reconsideration of the claims is respectfully requested.

**I. CLAIM REJECTION UNDER 35 U.S.C. § 112, second paragraph (Indefiniteness):**

Claims 1 and 4 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Examiner alleges that it is unclear how migration percentages are determined based on averaged assessment factor ratings.

There are two separate requirements under 35 U.S.C. § 112, second paragraph. MPEP § 2171, p. 2100-209 (8<sup>th</sup> ed., rev. 5, August 2006). The first is subjective and requires that the claims must set forth the subject matter that the *Applicants* regard as their invention. *Id.* The second is objective and requires that the claims must particularly point out and distinctively define the metes and bounds of the subject matter that will be protected by the patent grant (*i.e.*, whether the scope of the claim is clear to one of ordinary skill in the art). *Id.* at 2100-210. The Examiner should explain whether the rejection is based on indefiniteness or on the failure to claim what the Applicants regard as their invention. *Id.* (citing *Ex parte Ionescu*, 222 U.S.P.Q. 537, 539 (Bd. App. 1984)).

The Examiner is respectfully referred to the specification, e.g. at paragraphs 0028-0044, that describes how migration percentages are calculated, and how the assessment factor ratings include considerations of what is required onsite versus migrated, in an exemplary implementation.

Accordingly, the Applicants respectfully request the Examiner withdraw the § 112 rejection.

## **II. CLAIM REJECTION UNDER 35 U.S.C. §102**

Claims 1-3, 5-8, 10-13 and 15 were rejected under 35 U.S.C. § 102(a and e) as being anticipated by U.S. Publication No. 2003/0055697 to *Macken, Jr. et al.*, hereinafter “Macken”. This rejection is respectfully traversed.

Applicant respectfully notes that the statement of rejection does not include claims 4, 9, or 14, although these are mentioned in the Examiner’s discussion.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-67 (8<sup>th</sup> ed., rev. 5, August 2006) (*citing In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

The independent claims require collecting application data. This is not taught by Macken. The Examiner alleges this is taught at paragraph 0037, but is incorrect:

[0037] The customer's needs and processes are then be investigated in more detail. For example, a process migration "toolkit" (i.e., a set of tools adapted to facilitate process migration) may include a template associated with an initial questionnaire to be completed by the customer (e.g., a MICROSOFT.RTM. WORD template). Such a questionnaire might be used, for example, to understand a process and to estimate an amount of time that may be required at the first location to further investigate the process and/or to perform a migration. According to one embodiment, the questionnaire is automatically generated and/or transmitted to one or more customer employees (e.g., one section of the questionnaire may be transmitted to a human resources manager while another section is transmitted to a legal department). By way of example, the initial questionnaire could include some or all of the following sections: a contact list, a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations.

The "questionnaire" can include sections such as a process description (e.g., including operations, measurements, control aspects and evolution), information technology aspects, human resources aspects, financial aspects, quality information, legal issues and customer expectations, but is not taught to include application date.

. *Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

The independent claims require assigning ratings according to a plurality of assessment factors. Macken does mention a "scorecard" in which factors are rated.

The independent claims require averaging the ratings to determine an average rating. This is not taught by Macken. The Examiner alleges that this is taught at paragraph 0039, but is mistaken:

[0039] FIG. 4 is a process migration scorecard display 400 according to some embodiments of the present invention. As can be seen, the

display 400 includes a feasibility scorecard and a risk assessment scorecard. Each scorecard includes a number of factors that are rated from "0" (difficult migration) to "5" (easy migration). For example, the complexity of the process is rated "2" indicating that some knowledge and/or ability will be required to perform the process. An overall score is then computed based on these ratings, and the overall score is used to determine whether the process should be migrated. According to one embodiment, certain ratings result in pre-determined actions. For example, a rating below "3" may trigger generation of a risk mitigation action plan.

It is clear that while an "overall score" is indicated, there is no teaching at all in Macken of determining an average rating or that the "overall score" is an average of anything.

The independent claims also require determining employee migration percentages according to the average rating. This is not taught by Macken, although the Examiner incorrectly alleges it is taught at paragraph 0041:

[0041] Information associated with Full Time Employee (FTE) values (e.g., fifty employees from January through September and sixty employees from October through December) and ramp-up plans for the second location may also be determined via a process migration toolkit template. Prior customer staffing plans (i.e., historical information) can also be used to determine appropriate FTE values. According to one embodiment, information in a FTE plan is automatically used to generate requisitions, such as human resources, technology and/or telecommunication requisitions. For example, a human resources requisition form may be generated and used to initiate hiring of new employees needed for the process. The human resources requisition may also indicate the appropriate skills that are required for those employees (e.g., UNIX.RTM. and database administrator skills).

It is clear that this "information" is not taught to include migration percentages, and is not taught to correspond to any average rating.

As Macken fails to teach multiple limitations of the independent claims, all rejections are traversed. Accordingly, the Applicants respectfully request the Examiner withdraw the § 102 rejection with respect to these claims.

The Examiner is invited to telephone the undersigned to resolve any remaining issues before allowance.

**CONCLUSION**

As a result of the foregoing, the Applicants assert that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

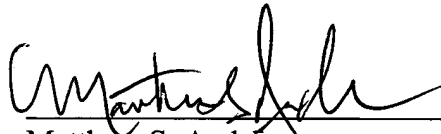
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 05-0765.

Respectfully submitted,

MUNCK BUTRUS CARTER, P.C.

Date: 03/28/2008



Matthew S. Anderson  
Registration No. 39,093

Docket Clerk, MB/EDS  
P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: *manderson@munckbutrus.com*